

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Erwin Wolf
Serial No: 10/599,736
Filed: 10/6/2006
Title: Actuator
Examiner: Daniel D. Yabut
Art Unit: 3656

**Commissioner for Patents
Alexandria, VA 22313-1450**

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

In response to the office action dated 2/3/2009, Applicant herewith elects the **"species" II, disclosed in Figs. 10, 11, 14, 15, with claims 22-24, 29-31, 33, 40, and 42** drawn to this "species", for further prosecution **with traverse**.

The instant application is a national stage filing and therefore the concept of **unity of invention** applies (see **MPEP 1893.03(d) Unity of Invention**). The examiner states that the species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 and discusses on page 3 that the species I to IV listed on page 2 do not relate to a single general inventive concept because the species lack the same or corresponding special technical features and because several features of the identified species are not mutually included in the claims of the other species.

Examiner seems to misinterpret the "special technical feature" requirement of PCT Rule 13.2 which reads (emphasis added):

"Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only **when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features**. The expression **"special technical features"** shall mean those technical features that **define a contribution** which each of the **claimed inventions**, considered as a whole, **makes over the prior art**.

MPEP 1893.03(d) sets forth in regard to this issue that (emphasis added):

“A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. **The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.** For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key.”.

Thus the issue is whether there is a special technical feature that defines the contribution which each claimed invention makes over the prior art. The examiner himself has identified generic claims 22-24 and 29 that concern ALL “species”. There are therefore claimed features that are common to all “species” and there is thus a technical relationship based on at least one common special technical feature. The examiner has not identified any prior art that would anticipate or make obvious the claimed subject matter of claims 22-24 and 29 and, absent such a showing, there is a technical relationship with special technical features making a contribution over the art. A single general inventive concept is therefore provided based on claims 22-24 and 29.

Applicant would also like to point out that the international search report has identified only references of the category “A” so that the instant claims appear to be allowable.

Authorization is herewith given to charge any fees or any shortages in any fees required during prosecution of this application and not paid by other means to Patent and Trademark Office deposit account 50-1199.

Respectfully submitted on March 5, 2009,

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